



PATENT
P56668

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Lynn G. Hilden

Serial No.: 10/085,069

Examiner: J. Bergin

Filed: 1 March 2002

Art Unit: 3641

For: RAPID DEFLAGRATION CORD (RDC) ORDNANCE TRANSFER LINES

RENEWED PETITION UNDER 37 CFR §1.144

Mail Stop: **Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision on Petition, mailed 23 February 2007, entry and consideration of the following timely filed renewed petition is respectfully requested.

Folio: P56668
Date: 3/2/07
I.D.: REB/MDP

STATEMENT OF FACTS

1.) An Election/Restriction was mailed on 12 February 2003 requiring the Applicant to elect a single disclosed species for prosecution between Group (I) a semi flexible tubing of FIG. 3 and Group (II) a coiled tubing of FIG. 27, and upon such election elect 1) what end fitting each end of the transfer line is connected to (PP, LE, standard HE, separation HE, etc) and to 2) also specify whether or not a manifold is present at each end and then to 3) specify exactly how many ports are in all manifolds present in the elected specie and then to 4) specify exactly what end fittings are in each port of each manifold attached to the transfer line.

2.) On 12 March 2003 Applicant filed an Election with traverse electing Group I, the semi flexible tubing of FIG. 3 connecting a percussion primer to a standard HE end fitting, and identified claims 1-5, 8-10, 23-26, 29-30 and 33-35 as being generic to all the species, and identifying claims 1-5, 8-11, 23-26, 28-30 and 33-35 as being pertinent to the elected species.

3.) A second Election/Restriction was mailed on 30 May 2003, withdrawing the Election/Restriction mailed on 12 February 2003, requiring the Applicant to elect a single disclosed species for prosecution between Group (I) a semi flexible tubing of FIG. 3 and Group (II) a coiled tubing of FIG. 27, and upon such election elect 1) a single specie of what each of the first and second ends of the transfer line are connected to 2) also specify whether or not a manifold is present at each end and then to 3) specify exactly how many ports are in all manifolds present in the elected specie

and then to 4) specify exactly what end fittings are in each port of each manifold attached to the transfer line.

4.) On 2 July 2003 Applicant filed an Election with traverse electing Group I, the semi flexible tubing of FIG. 3 connecting a percussion primer (Fig. 4) to a standard HE end fitting (Fig. 20), where the first end of the PP end fitting being absent any transfer manifold and the second end with the standard HE end fitting being lodged in a three port manifold, where the other two ports have a standard LE end fitting and a standard HE end fitting respectively. and identified claims 1-5, 8-10, 23-26, 29-30 and 33-35 as being generic to all the species and as being pertinent to the elected species.

5.) A first Office action on the merits was mailed on 30 March 2004, in which the Examiner disagreed with Applicant's identification of claims reading on the elected species, argued "undue burden" would be place upon the Examiner to search all the claims. The Examiner then determined that claims 33-35 read on each of the elected species, and examined only claims 33-35 on the merits.

6.) On 25 June 2004 the Applicant filed an Amendment in response to the 03/30/2004 Office action, canceling claims 1-32, amending claims 33-35 and adding new claims 36-65. Additionally, the Applicant repeated the argument that claim 33 was a generic claim, as the Examiner did not traverse this holding, and further identified new claim 54 as also being generic.

7.) An Office Communication was mailed on 23 March 2005, holding the Amendment filed 06/25/2004 not fully responsive.

8.) On 25 April 2005 the Applicant filed a Substitute Amendment in response to the 03/23/2005 Office Communication, canceling claims 1-32, amending claims 33-35 and adding new claims 36-65. Additionally, the Applicant repeated the argument that claim 33 was a generic claim, as the Examiner did not traverse this holding, and further identified new claim 54 as also being generic. Also, based on the Examiner's previous indication that the Amendment filed 06/25/2004 not fully responsive, the Applicant identified claims 33-49, 52, 53, 54-57 and 62-65 as reading on the elected invention. Claims 47-49, 58 and 59 were identified as being specific to the PP loaded end fittings; claims 52, 53, 62 and 63 were identified as being specific to the HE loaded end fittings; and claims 50, 51, 60 and 61 were identified as being specific to the non-elected LE loaded end fittings. It was also noted that as stipulated in MPEP §803, if the search can be made without serious burden, the examiner must examine it on the merits. The Examiner had not shown that there was any serious burden in examining claims drawn towards the LE loaded end fittings.

9.) An Office Communication was mailed on 27 July 2005, holding the Substitute Amendment filed 04/25/2005 not fully responsive.

10.) On 28 November 2005 the Applicant filed a Substitute Amendment in response to the 03/23/2005 Office Communication, canceling claims 1-32, amending claims 33-35 and adding new

claims 36-65. Additionally, the Applicant repeated the argument that claim 33 was a generic claim, as the Examiner did not traverse this holding, and further identified new claim 54 as also being generic. Further, the Applicant maintained the identification of claims 33-49, 52, 53, 54-57 and 62-65 as reading on the elected invention. Claims 47-49, 58 and 59 were identified as being specific to the PP loaded end fittings; claims 52, 53, 62 and 63 were identified as being specific to the HE loaded end fittings; and claims 50, 51, 60 and 61 were identified as being specific to the non-elected LE loaded end fittings. It was also noted that as stipulated in MPEP §803, if the search can be made without serious burden, the examiner must examine it on the merits. The Examiner had not shown that there was any serious burden in examining claims drawn towards the LE loaded end fittings.

11.) An Office Communication was mailed on 31 January 2006, holding the Substitute Amendment filed 11/28/2005 not fully responsive.

12.) On 28 February 2006 November 2005 the Applicant filed a Substitute Amendment in response to the 01/31/2006 Office Communication, canceling claims 1-32, amending claims 33-35 and adding new claims 36-65. Additionally, the Applicant repeated the argument that claim 33 was a generic claim, as the Examiner did not traverse this holding, and further identified new claim 54 as also being generic. Further, the Applicant maintained the identification of claims 33-49, 52, 53, 54-57 and 62-65 as reading on the elected invention. Claims 47-49, 58 and 59 were identified as being specific to the PP loaded end fittings; claims 52, 53, 62 and 63 were identified as being specific to the HE loaded end fittings; and claims 50, 51, 60 and 61 were identified as being specific to the non-

elected LE loaded end fittings. It was also noted that as stipulated in MPEP §803, if the search can be made without serious burden, the examiner must examine it on the merits. The Examiner had not shown that there was any serious burden in examining claims drawn towards the LE loaded end fittings.

13.) Paper No. 20050514 was mailed on 19 May 2006 enclosing a new Restriction Requirement requesting the Applicant elect Group I, claims 33-53 drawn to an RDC cord hermetically encapsulated in a metal tubing, classified in Class 102, subclass 275.1 or Group II, claims 54-65 drawn to an RDC cord filling an aluminum tube, a surrounding stainless steel tube, classified in Class 102, subclass 275.1.

14.) On 19 June 2006 the Applicant filed an Amendment and Election adding new claims 66 and 67, and electing, with traverse, Group II, claims 54-67. It was also noted that as stipulated in MPEP §803, if the search can be made without serious burden, the examiner must examine it on the merits.

15.) A "final" Office action (Paper No. 20060901), withdrawing claims 33-53, 66 and 67 and examining claims 54-65 on the merits, was mailed on 8 September 2006 maintaining the Restriction by making the Restriction requirement final.

16.) On 8 December 2006, a Petition under 37 CFR. §1.144. requesting withdrawal of the restriction was filed.

17.) On 23 February 2007 a Decision on Petition denying the request was mailed.

Accordingly, Applicant requests reconsideration of the Decision on Petition. See page 11, below.

ARGUMENTS

The facts of this case clearly indicate a reluctance on the Patent and Trademark Office (PTO) to Examine all the claims on the merits.

The Applicant initially identified claims 1-5, 8-11, 23-26, 28-30 and 33-35 as being pertinent to the elected species in response to the requirement for election in the communications from the PTO on 12 February 2003 and 30 May 2003.

The PTO, instead of examining claims 1-5, 8-11, 23-26, 28-30 and 33-35, chose instead to Examine only claims 33-35 on the merits.

The Applicant identified claim 33 as being generic to the elected species, however, it should be quite clear that claim 33 did not include feature limiting the invention claimed therein to certain ones of the elements set forth in the disclosure. In particular, the Applicant elected Group I, the **semi flexible tubing** of FIG. 3 connecting a **percussion primer** to a **standard HE end fitting**, based on the election criteria suggested by the PTO. However, original claim 33 did not specifically claim the **semi flexible tubing**, a **percussion primer** or a **standard HE end fitting**.

The PTO cannot read into and limit a claim to features of the disclosure. Therefore, claim 33 was not limited to the specific elected features. Instead, claim 33 was deemed to be generic, and the Examiner never argued that claim 33 was not generic.

Accordingly, at least claim 33 should have been examined on the merits during the Examination of claim 54.

Note also that the only difference between claim 54 and claim 66, for example, is that claim 66 requires that the semi-flexible stainless steel tube (claim 66) *hermetically* encapsulate the rapid deflagrating cord (claim 33). The Applicant has argued numerous times that claim 54 is generic.

Accordingly, if claim 54 contains allowable subject matter, then claim 66 contains allowable subject matter. The feature of *hermetically encapsulating said rapid deflagrating cord from said first end to said second end of said transfer line* merely narrows the scope of claim 66 as compared to claim 54.

As noted above, claims 33-35 were examined on the merits in the Office action mailed 30 March 2004. Additionally, claims 54-65 were examined on the merits in the Office action mailed 8 September 2006.

Accordingly, although the Examiner alleges a serious burden would be placed upon the Office in order to examine claims 33-35, such an allegation is untenable because claims 33-35 have already been examined on the merits.

Additionally, the Examiner holds that not only would class 102, subclass 275,1 need be searched, but also subclasses 275.2, 275.3, 275.4, 275.5, 275.6, 275.7, 275.8, 275.9, 275.11, 275.12 would all have to be searched. The Examiner has not explained why all these subclasses would have to be searched, nor has the Examiner explained why all these subclasses have not already been searched with respect to the previous examination on the merits of claims 33-35.

Additionally, the Examiner has not explained how all these subclasses were not required to be searched with respect to the examination on the merits of claims 54-65.

We note that claim 33 calls for a first metal tubing *hermetically* encapsulating a rapid deflagrating cord. There is no specific subclass in class 102 limited to hermetically sealed tubes. Accordingly, although claim 54 does not call for the claimed semi-flexible stainless steel tube to *hermetically* encapsulate the rapid deflagrating cord, the lack of such a feature in claim 54 does not suggest an area of search divergent from the search required for claim 33.

Similarly, although claim 54 calls for a semi-flexible stainless steel tube, there is no specific subclass in class 102 limited to semi-flexible stainless steel tubes. And there is no limitation in claim 33 precluding the use of a semi-flexible stainless steel tube as the claimed *first metal tubing* hermetically encapsulating the rapid deflagrating cord.

A review of each feature of claim 33, as compared to each feature of claim 54 finds no evidence that a divergent area of search would be required in class 102, and the Examiner has not identified which feature of claim 54 which would provide evidence that a particular subclass, of those listed above, would not need to be searched.

With respect to the formulation of a search query with respect to an EAST text search in USPAT, USPGPUB, USOCR, JPO, EPO, Derwents Abstracts, C06C005/00.ipc., C006005/04.ipc. and C06C005/06.ipc., the only difference in search terminology would be based on the features of a hermetic seal and the use of a semi-flexible stainless steel for the metal tube.

Both claims calls for a rapid deflagrating cord extending from a first end and a second end of a transfer line (i.e., filing an aluminum tube); the rapid deflagrating material having a burn a rate of 1000 to 1500 feet per second; and a metal tubing being crimped at each end thereof, onto the transfer line at first and second ends of the transfer line, to hold the rapid deflagration cord in place

in the first metal tubing.

Accordingly, there is no serious burden placed on the Examiner in searching all the current claims.

The Decision my Dir. Donald Hajec, in response to the foregoing, appears to contain the following errors, and should be reconsidered:

A. Dir. Hajec indicated that since claim 33 was restricted from claim 54, the restriction was not subject to an *election*.

a. This is contrary to MPEP §800 and in particular to MPEP §818, "Election is the designation of the particular one of two or more disclosed inventions that will be prosecuted in the application."

B. Dir. Hajec appears to suggest that the election was not proper.

a. There was no indication in the final Office action that the election was not proper, and the Examiner accepted the election and made the requirement final.

C. Dir. Hajec has suggested that claim 33 is not generic:

a. Dr. Hajec states that "in claim 33, the metal tubing is crimped onto the transfer line whereas in claim 54 there is no mention of either tubes being crimped onto the

transfer line."

- a-1. Claim 33 calls for, in part, *said first metal tubing being crimped at each end thereof, onto said transfer line at said first and second ends of said transfer line, to hold said rapid deflagration cord in place in said first metal tubing,* and claim 54 calls for, in part, *each end portion of said stainless steel tube being crimped onto said aluminum tube to hold said aluminum tube in place.*

There is no disclosed difference, and there has been no showing that the aluminum tube of claim 54 is different from the transfer line of claim 33. The use of transfer line in claim 33 is broader, and thus generic, to the term aluminum tube in claim 54.

- b. Dr. Hajec states that claim 54 does not require a "deflagration cord, and would read on the deflagration material being directly applied within the aluminum tube.
- b-1. As evidenced by claim 42, the rapid deflagrating cord is comprised of a rapid deflagration material of $\text{Cs}_2\text{B}_{12}\text{H}_{12}$ mixed with KNO_3 ; and a metal encasement surrounding said rapid deflagration material. See also, paragraph [0067] of the specification. Accordingly, the *aluminum tube* and *rapid deflagrating material filing said aluminum tube* set forth in claim 54 comprise a "rapid deflagrating cord."

D. Regarding "Serious Burden":

- a. Dir Hajec indicates that since claim 33 no longer claims elements previously considered during a first examination on the merits that art disregarded would need to be reexamined.
 - a-1. It is required, during examination, that a search be made for all the elements of the invention. Accordingly, art should have been looked for that could be applied to the all components (e.g., not deleted by the amendment) that may be used in making a rejection under 35 U.S.C. §103(a). It is also required that a search not be made in a vacuum, and that features of the disclosed invention also be considered.
- b. Dir. Hajec suggests that the Examiner's area of search is taken at face value, and that the applicant failed to provide evidence to the contrary.
 - b-1. The Applicant did provide such evidence. For example, the Applicant noted that the only difference between claim 33 and claim 54 is that claim 33 calls for a first metal tubing *hermetically* encapsulating a rapid deflagrating cord. There is no specific subclass in class 102 limited to hermetically sealed tubes. Accordingly, although claim 54 does not call for the claimed semi-flexible stainless steel tube to *hermetically* encapsulate the rapid deflagrating cord, the lack of such a feature in claim 54 does not suggest an area of search divergent from the search required for claim 33.

CONCLUSION

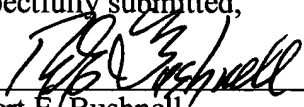
It has been shown that claim 33 is a generic and that there was no serious burden to examine the non-elected claims.

REMEDY REQUESTED

The Commissioner is respectfully requested to:

1. Set aside the Decision on Petition, and Withdraw the Restriction;
2. Set aside the Amendment filed 2 March 2007;
2. Provide a non-final Office action on the merits with respect to all the claims; and
3. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,


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